

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte H. GRANT JORGENSEN

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Appeal No. 1999-0090  
Application 08/239,700<sup>1</sup>

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ON BRIEF

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Before CALVERT, COHEN and GONZALES, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 6, all the claims in the application.

The appealed claims are drawn to artificial cusplless posterior upper and lower teeth, and are

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<sup>1</sup> Application for patent filed May 9, 1994. According to appellant, this application is a continuation-in-part of Application 07/983,693, filed December 1, 1992, now U.S. Patent No. 5,326,262, granted July 5, 1994.

reproduced in the appendix of appellant's brief.

The references applied in the final rejection are:

Dickson	2,416,983	Mar. 4, 1947
Heckhausen (German Patent)	1,230,521	Dec. 15, 1963 <sup>2</sup>

Claims 1 to 6 stand finally rejected under 35 U.S.C. § 103 as unpatentable over Heckhausen in view of Dickson.

The basis of the rejection, as set forth on page 3 of the examiner's answer, is:

Heckhausen shows upper and lower teeth configured to the average value of a compensating curve (articulation curve, see page 2 of the translation). While Heckhausen does not specifically state that the compensation curve is the curve of Spee, it would have been obvious to one of ordinary skill in the art to modify Heckhausen to include shaping the teeth with respect to the curves of Spee or medium incline z-z as taught by Dickson in Fig. 2 and at col. 4 line 43 to col. 5 line 43 in order to obtain a more effective bite. Since the curves referred to in the claims depend on the individual, the possible resulting structure of the occlusal surface of the teeth as claimed is a broad range depending on the range of shapes of different individuals. In view of this, the specific shapes of the tooth as related to the existing curves of Spee and Wilson are obvious in view of the teaching of Heckhausen and Dickson.

After fully considering the record in light of the arguments presented in appellant's brief and reply brief, and in the examiner's answer and supplemental answer, we conclude that the rejection of claims 1 to 6 should not be sustained, and that claims 4 to 6 should be rejected pursuant to 37 C.F.R. §

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<sup>2</sup> A translation of this reference is attached to the examiner's answer. All references herein to pages and lines of Heckhausen are to pages and lines of the translation.

1.196(b).

Claims 1 to 3

Each of these claims recites that the functional occlusal surfaces of the artificial teeth are configured to conform to certain curves. For example, claim 1 reads:

1. Artificial cusplless posterior upper and lower teeth comprising functional occlusal surfaces configured to conform to the restored curves of Spee in an anterior posterior direction.

Appellant and the examiner seem to be in agreement that these claims require that the functional occlusal surfaces of the teeth form segments of the curve(s) in question; for example, as to claim 1, that the functional occlusal surfaces are segments of a curve whose center of curvature is coincident with the center of curvature of the restored curve of Spee. The examiner takes the position that since Dickson discloses arranging the teeth along the curve of Spee, it would have been obvious "to modify Heckhausen to include shaping the teeth with respect to the curves of Spee or medium incline z-z as taught by Dickson" (answer, page 3). However, we do not agree, because it appears that Dickson's teaching that his (cusped) artificial teeth should be set with their crowns 33 on the curve of Spee is in essence a disclosure that they be set to replicate natural teeth (as shown in appellant's Fig. 1). In our view, if this teaching of Dickson were applied to the teeth of Heckhausen by one of ordinary skill, the Heckhausen teeth would, at most, be set so that the tips of their chewing surfaces ("crowns") followed or were tangent to the curve of Spee, rather than rounding their chewing surfaces so that they would all

lie along the curve of Spee as segments thereof (similar to appellant's Fig. 2). We do not consider that one of ordinary skill would regard Heckhausen's disclosure that the last few teeth be "set up individually, although in one piece, in accordance with the average value of the compensating curve (articulation curve)" (page 2, line 12 to 14) as suggesting that the chewing surfaces of the teeth, taken together, form a continuous curve (as shown in appellant's Fig. 2). This is particularly the case since Heckhausen shows in Fig. 2 two adjoining upper teeth 11, 12, each having at its lower end a radius which is apparently about a center located on the centerline of the individual tooth, rather than the lower ends both having a radius emanating from a common center of curvature.

#### Claims 4 to 6

These claims each recite that the teeth are "designed to function along" certain curves. For example, claim 4 recites:

4. Artificial cusplless posterior upper and lower teeth designed to function along the restored curves of Spee in an anterior posterior direction.

Unlike the expression "configured to conform to" in claims 1 to 3, we do not find any antecedent basis in appellant's specification for the expression "designed to function along". See 37 C.F.R. § 1.75(d)(1).

In order to comply with the second paragraph of 35 U.S.C. § 112, the claim language, when read by a person of ordinary skill in light of the specification, must describe the subject matter with sufficient precision that the bounds of the claimed subject matter are distinct,

In re Merat, 519 F.2d 1390, 1396, 186 USPQ 471, 476 (CCPA 1975), i.e., a claim must reasonably

apprise those of skill in the art of its scope. In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). In the present case, the appellant and the examiner seem to have treated claims 4 to 6 as being of the same scope as claims 1 to 3, respectively, but since the language of claims 4 to 6 is different from that of claims 1 to 3, respectively, the two sets of claims are presumably intended to be of different scope. However, particularly in light of the lack of antecedent basis in the specification, as noted supra, we do not consider that one of ordinary skill would reasonably be able to determine what the scope of claims 4 to 6 is intended to be. In particular, it is not clear whether claims 4 to 6 are intended to be of such scope that claim 4, for example, is intended to cover artificial cusplless posterior teeth other than those in which the occlusal surfaces of the teeth form segments of the restored curve of Spee (as shown in Fig. 2), and if so, what other structure is intended to be covered thereby.

Accordingly, in view of the indistinctness of the scope of claims 4 to 6, they are rejected pursuant to 37 C.F.R. § 1.196(b) for failure to comply with the second paragraph of 35 U.S.C. § 112.

When the language of a claim is such that in order to reject the claim under 35 U.S.C. § 103 it would require considerable speculation as to the meaning of terms therein and assumptions as to its scope, the claim should be rejected under § 112, second paragraph, not § 103. In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). Therefore, since such speculation and assumptions as to claims 4 to 6 would be required for the reasons discussed above, the

rejection of claims 4 to 6 under § 103 will not be sustained. This action is procedural in nature and should not be taken as an indication that, if the § 112 rejection is overcome, claims 4 to 6 would necessarily be patentable over the applied and/or other prior art.

### Conclusion

The examiner's decision to reject claims 1 to 6 is reversed. Claims 4 to 6 are rejected pursuant to 37 C.F.R. § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 C.F.R. § 1.196(b) provides that, “A new ground of rejection shall not be considered final for purposes of judicial review.”

37 C.F.R. § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

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(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REVERSED  
37 C.F.R. § 1.196(b)

IAN A. CALVERT	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
	)	APPEALS AND
IRWIN CHARLES COHEN	)	INTERFERENCES
Administrative Patent Judge	)	
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JOHN F. GONZALES	)	
Administrative Patent Judge	)	

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